REMARKS

In the Official Action, the Examiner rejected pending claims 19-29 under 35 U.S.C. § 103(a) and 35 U.S.C. § 112. Claim 19 has been amended to set forth the recited subject matter more clearly, and new claim 30 has been added. Applicants respectfully request reconsideration of the application in view of the remarks set forth below. Applicants believe that all pending claims are in condition for allowance.

Objections to the Specification

The Examiner objected to the specification because "the related application has already matured into a patent." As such, a replacement paragraph has been provided that includes the patent number and issue date of the related patent.

Claim Rejections under 35 U.S.C. § 112, Second Paragraph

The Examiner rejected claims 19-29 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicants have amended claim 19 and respectfully submit that, as amended, claims 19-29 fully comply with 35 U.S.C. §112.

Specifically, the Examiner asserted that:

a) "the surface tension" (claim 19, line 5) lacks proper antecedent basis.
b) "wherein act (a) comprises providing" (claim 20, line 1) should be: --wherein the substrate is --.
c) "wherein act (c) comprises" (claims 21-29, line 1) should be: -- wherein step c) further comprises--.

The Examiner rejected claim 19 under 35 U.S.C. § 112, second paragraph, as providing insufficient antecedent basis for the limitation of the claim and thus failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Accordingly, claim 19 has been amended to correct the antecedent basis of "the surface tension" in order to overcome the Examiner's rejection and thereby render the claim definite under 35 U.S.C. § 112. The original scope of claim 19 has not changed as a result of this amendment.

Next, the Examiner rejected claim 20 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention by using the phrase "wherein act (a) comprises providing." Claim 19, from which claim 20 depends, has been amended to recite "the acts of" in the preamble. Applicants respectfully submit that this amendment provides sufficient antecedent basis to overcome the Examiner's rejection of claim 20. Accordingly, the Applicants respectfully request withdrawal of the Examiner's rejection of claim 20. The original scope of claim 20 has not changed as a result of this amendment.

Similarly, the Examiner rejected claims 21-29 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention by using the word "act" instead of the word "step" to refer to the sub-parts of independent claim 19. As stated above, claim 19, from which claims 21-29 depend, has been amended to recite "the acts of" in the preamble. As such, Applicants respectfully submit that this amendment provides sufficient antecedent basis to particularly point out and distinctly claim the

subject matter which Applicants regard as the invention. Accordingly, the Applicants respectfully request withdrawal of the Examiner's rejection of claims 21-29. The original scope of claims 19-29 have not changed as a result of this amendment.

For the reasons set forth above, Applicants respectfully requests withdrawal of the Examiner's rejection under 35 U.S.C. § 112, second paragraph.

Rejections under 35 U.S.C. § 103

The Examiner rejected claims 19-26 and 29 under 35 U.S.C. § 103(a) as being unpatentable over Jiang et al (US 6,048,755). Applicants respectfully assert that this point is irrelevant because the Jiang reference is not valid prior art under 35 U.S.C. §103(a).

35 U.S.C §103(a) states that:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in he art to which said subject matter pertains.

The term "prior art" as used in Section 103 refers "to the statutory material named in 35 U.S.C. § 102. *Riverwood International Corp. v. R.A. Jones & Co., Inc.*, 324 F.3d 1346, 1354; 66 U.S.P.Q.2d 1331, 1337 (Fed. Cir. 2003).

Before examining why the Jiang reference is not valid prior art under 35 U.S.C. § 103(a), it is first necessary to ensure that the Examiner has the correct priority date for the present

application. Under 35 U.S.C. § 120, an application "which is filed by an inventor or inventors named in a previously filed application shall have the same effect...as though filed on the date of the prior application, if filed before the patenting...[of] the first application...if it contains or is amended to contain a specific reference to the earlier filed application." Patent number 6,388,199 (hereafter referred to as the '199 patent) was filed on July 31, 2000 and issued on May 14, 2002. The '199 patent has the same inventors as the present application. The present application was filed on December 12, 2001, which is clearly before May 14, 2002. At the time of filing, the present application was amended to contain a specific reference to serial number 09/628,833, matured as the '199 patent. As such, under 35 U.S.C. § 120, the present application is entitled to an effective filing date of July 31, 2000.

The Jiang Reference is not valid prior art under 35 U.S.C. § 102(b)

The Jiang reference does not qualify as prior art under 35 U.S.C. § 102(b). To qualify as prior art under 35 U.S.C. § 102(b) as to the present application, the issue date of a reference must have been more than one year prior to the effective date of the application, i.e. prior to July 31, 1999. Because the Jiang reference did not issue until April 11, 2000, it does not qualify as 102(b) prior art.

The Jiang Reference may be removed under Rule 131

35 U.S.C. § 102(a) states that " a person shall be entitled to a patent unless...the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent." Thus, in order for a patent to qualify as prior art under 35 U.S.C. §102(a) against an application,

it must be patented or disclosed in a printed publication prior to the invention date of the pending application.

Under Rule 131, Applicants may overcome this type of prior art rejection by filing an appropriate declaration that establishes the invention of the claimed subject matter for the rejected claims prior to the effective date of the reference. The prior invention may be shown by demonstrating conception of the invention prior to the activity on which the rejection is based coupled with reasonable diligence from prior to the effective date of the reference to the filing of the application. Here, Applicants have attached a declaration signed by the attorney that prepared and filed both the present application and its parent application, which demonstrates that the invention disclosed and claimed in the present application was conceived prior to the effective date of the Jiang reference and was constructively reduced to practice with reasonable diligence from prior to the effective date of the Jiang reference.

The conception is supported by a written description of the invention by the inventors prepared prior to April 11, 2000. *See* Exhibit A and Declaration of Robert A. Manware Under 37 C.F.R. § 1.131, herein referenced as Declaration, paragraph 4. Furthermore, Applicants provide evidence of reasonable diligence from prior to April 11, 2000, the issue date of the Jiang reference, to the filing of the parent of the present application on July 31, 2000. The reasonable diligence is supported by: (1) a redacted reporting letter, which is attached as Exhibit B; (2) a second redacted reporting letter, which is attached as Exhibit C; and (3) a true and correct copy of U.S. Patent 6,388,199, which is

attached to the Declaration as Exhibit D. The reasonable diligence is also supported by Declaration of Robert A. Manware under 37 C.F.R. § 1.131. Based on this declaration and the exhibits, it is clear that Mr. Manware began work on the present application prior to April 11, 2000. *See* Declaration, paragraph 4 and Exhibit A. At least as early as April 24, 2000, Mr. Manware prepared a draft patent application of the present application and forwarded it to the inventors for comments. *See* Declaration, paragraph 5 and Exhibit B. Then, at least as earlier as June 13, 2000, Mr. Manware prepared a revised patent application of the present application and forwarded it to the inventors for comments. *See* Declaration, paragraph 6 and Exhibit C. Lastly, on July 31, 2000, Mr. Manware filed the parent application of the present application. *See* Declaration, paragraph 7 and Exhibit D. As such, Applicants were reasonably diligent from before April 11, 2000 to the filing of the parent of the present application on July 31, 2000.

The Rule 131 Declaration establishes that the date of invention of the claimed subject matter is prior to the issue date of the Jiang reference. Thus, the Jiang reference is not prior art under 35 U.S.C. § 102(a) because the Jiang reference issued *after* the date of invention of the present application.

The Jiang Reference is not valid prior art under 35 U.S.C. § 102(e)/103(c)

Lastly, Applicants respectfully submit that the Jiang reference does not qualify as prior art against the above-referenced application under 35 U.S.C. § 102(e)/103(c). In accordance with 35 U.S.C. § 103(c) and Pub.L. 106-113, § 4807 enacted November 29, 1999, subject developed by another person which qualifies as prior art only under subsection (e) of 35 U.S.C. § 102, shall not

preclude patentability where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Here, the Jiang et al. reference and the claimed invention were, at the time the invention was made, owned by the present assignee, Micron Technology, Inc. or subject to an obligation of assignment to Micron Technology, Inc. For this reason, it is clear that the Jiang reference does not qualify as prior art under 35 U.S.C. § 102(e)/103(c).

Without the Jiang reference, the Examiner's rejection under 35 U.S.C. § 103 is moot, because it alone is the basis for the Examiner's rejection. Accordingly, Applicants respectfully request withdrawal of the Examiner's rejection and allowance of claims 19-30.

Conclusion

In view of the remarks set forth above, Applicant respectfully requests reconsideration of the Examiner's rejections and allowance of all pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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